

AMENDMENTS TO THE DRAWINGS

Two Replacement Sheets of drawings are attached as Appendix A, following page 27 of this paper. The first Replacement Sheet includes amended FIG. 1B, which replaces originally submitted FIG. 1B. The second Replacement Sheet includes previously submitted FIG. 2, as well as new drawings FIG. 1C and FIG. 1D.

In response to the Examiner's drawings objections stated in the January 10, 2005 Office Action, FIG. 1B has been amended to show the flexible eartip 39. Applicants submit that no new matter has been introduced.

As previously requested by Examiner Grier and Supervising Examiner Singhtran in a telephone interview with Applicants' representatives on February 8, 2005, Applicants are submitting new drawings FIG. 1C and FIG. 1D to clarify how an insert earphone embodiment of the invention may be supported by the ear canal of a user. More specifically, new drawing FIG. 1C illustrates a full insertion of an ear phone into an ear canal of a user and new drawing FIG. 1D illustrates a shallow, or partial insertion of an ear phone into an ear canal of a user. Applicants submit that new FIG. 1C and FIG. 1D are fully supported by the specification and claims (for example, please see claim 1), and therefore, no new matter has been introduced.

REMARKS

Claims 1-46 are pending in the instant application. Claims 8-21 have been cancelled without prejudice. Claims 24-34 have been allowed. Claims 1, 3-7, 22-23, 35-36, 38-41, and 43-46 have been rejected. Claims 2, 37, and 42 have been objected to. Applicants thank Examiner Grier and Supervising Examiner Singhtran for their telephone interview with Applicants' representatives on February 8, 2005 (herein, the Interview). Applicants respectfully request reconsideration of the claims.

I. **Rejection of Claims under 35 U.S.C. § 102 With Respect to Claims 1 and 4-5 and Rejection of Claims under 35 U.S.C. § 103 With Respect to Claims 41 and 43-44**

Claims 1 and 4-5 were rejected under 35 U.S.C. § 102(b) as being anticipated by Hosaka et al. (herein, Hosaka), U.S. Patent No. 5,781,638. Similarly, claim 41 and 43-44 were rejected under 35 U.S.C. § 103(a), in view of Hosaka.

According to the Office Action, Hosaka discloses every feature recited in the Applicants' claim 1. Also, according to the Office Action, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Hosaka by implementing an acoustic damper for the purpose of damping the transmission of the signal path with a tube and providing a modified frequency response of the earphone device as desired for optimal performance. The Applicants respectfully disagree and submit that Hosaka is different from the Applicants' invention, as set forth in claims 1 and 41 above, for at least the following reasons.

As explained by the Applicants' representatives during the Interview, Hosaka does not teach a tube nipple and a housing being configured and arranged to form an obtuse angle between a longitudinal axis of the tube nipple and a vertical axis of the housing, as claimed in claims 1 and 41. In addition, Hosaka fails to disclose an acoustic damper, as claimed in claim 41. Instead, Hosaka teaches that a main duct portion (7) of the reference earphone assembly is connected to a pinna inserting portion (5) via a bent portion (6) having an acute angle substantially equal to or slightly smaller than approximately 90° (col. 3, lines 48-52). Hosaka, therefore, teaches about an acute angle, which is an exact opposite of the obtuse angle taught by claim 1 and claim 41.

Additionally, Hosaka does not teach that the insert earphone is supported entirely by the ear canal when worn by the user. Instead, Hosaka teaches that the reference earphone assembly is attached and supported by the pinna of the acoustic duct of a user (col. 4, lines 22-28).

For at least the reasons set forth above, the Applicants respectfully assert that Hosaka does not teach, suggest or disclose the features recited in Applicants' claim 1. In the interest of time and to further prosecution of the present patent application, the Applicants have amended claims 1 and 41, as discussed during the Interview, to clarify that the obtuse angle is between a longitudinal axis of the tube nipple and a vertical axis of the housing, where the tube nipple meets the housing. Applicants respectfully submit that claims 1 and 41 are allowable over the cited reference, Hosaka. The

Applicants request that (1) the rejection of claim 1 under 35 U.S.C. § 102(b) over Hosaka, and (2) the rejection of claim 41 under 35 U.S.C. § 103 in view of Hosaka, both be withdrawn.

Claims 4-5 and claims 43-44 depend from independent claims 1 and 41, respectively. Because independent claims 1 and 41 are allowable over Hosaka, the Applicants respectfully submit that dependent claims 4-5 and 43-44 are also allowable over the cited reference. The Applicants assert that the rejections of claims 4-5 and 43-44 are now moot and request that (1) the rejection of dependent claims 4-5 under 35 U.S.C. § 102(b) over Hosaka, and (2) the rejection of claims 43-44 under 35 U.S.C. § 103 in view of Hosaka, both be withdrawn.

II. Rejection of Claims under 35 U.S.C. § 103 With Respect to Claims 3, 6-7, 22-23, 35-36, 38-41, and 43-46

Claims 3, 6-7, 22-23, 35-36, 38-41, and 43-46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hosaka.

With respect to claims 3 and 7, the Examiner admits that "Hosaka fails to disclose a flexible channel located between the output port of the receiver and the first end of the rigid tube nipple." Further, the Examiner alleges, without any supporting evidence, that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Hosaka by implementing a flexible material for constructing the acoustic path or tubing." Office Action at pages 5-6.

With respect to claim 6, the Examiner alleges, without any supporting evidence, that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Hosaka by implementation [sic] an acoustic damper for the purpose of damping the transmission of the signal path with tube and providing an [sic] modified frequency response of the earphone device as desired for optimal performance." Office Action at page 6.

With respect to claims 22-23, the Examiner admits that "Hosaka fails to disclose a flexible channel located between the output port of the receiver and the first end of the rigid tube nipple." Further, the Examiner alleges, without any supporting evidence, that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Hosaka by implementing a flexible material for constructing the acoustic path or tubing." Office Action at pages 6-7.

With respect to claim 35, the Examiner admits that "Hosaka fails to disclose the response of the TDH-39 standard." Further, the Examiner alleges, without any supporting evidence, that "it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Hosaka by providing TDH-39 standard quality of frequency response at 0db at a frequency of 6 or 8 KHz as desired for the purpose of acquiring an efficient frequency responses for optimal performance." Office Action at pages 7-8.

With respect to claims 38-39, the Examiner admits that "Hosaka fails to disclose

a flexible channel located between the output port of the receiver and the first end of the rigid tube nipple.” Further, the Examiner alleges, without any supporting evidence, that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Hosaka by implementing a flexible material for constructing the acoustic path or tubing.” Office Action at page 8.

With respect to claim 40, the Examiner admits that “Hosaka fails to disclose an acoustic damper.” Further, the Examiner alleges, without any supporting evidence, that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Hosaka by implementing an acoustic damper for the purpose of damping the transmission of the signal path with tube and providing an [sic] modified frequency response of the earphone device as desired for optimal performance.” Office Action at pages 8-9.

With respect to claim 41, the Examiner admits that “Hosaka fails to disclose an acoustic damper.” Further, the Examiner alleges, without any supporting evidence, that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Hosaka by implementing an acoustic damper for the purpose of damping the transmission of the signal path with tube and providing an [sic] modified frequency response of the earphone device as desired for optimal performance.” Office Action at page 9.

With respect to claims 45-46, the Examiner admits that “Hosaka fails to disclose

a flexible channel located between the output port of the receiver and the first end of the rigid tube nipple.” Further, the Examiner alleges, without any supporting evidence, that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Hosaka by implementing a flexible material for constructing the acoustic path or tubing.” Office Action at page 10.

Applicants respectfully challenge the conclusory assertions made in the Office Action that the elements recited in claims 3, 6-7, 22-23, 35, 38-41, and 45-46 are well known in the art or are obvious in the art. Applicants respectfully submit that, in the context of the elements as recited in independent claims 1, 22, 35, and 41, the elements recited in claims 3, 6-7, 22-23, 35, 38-41, and 45-46 are not well known or obvious.

Further, with regard to claims 3, 7, 22-23, 38-39, and 45-46, the Examiner alleges, without any supporting evidence, that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Hosaka by implementing a flexible material for constructing the acoustic path or tubing.” The Applicants would like to point out to the Examiner that the flexible channel, as claimed in the present invention, comprises only *a portion of the acoustic path*, and not the entire acoustic path. More specifically, the flexible channel is located between the output port of the receiver and the first end of the tube nipple (please see FIG. 1B, for example), which is not the entire acoustic path. Therefore, in order to maintain an

obviousness rejection with regard to claims 3, 7, 22-23, 38-39, and 45-46, the Examiner must produce a reference supporting a flexible channel as a *portion of* an acoustic path, and not the entire acoustic path as suggested in the Office Action.

M.P.E.P. § 2144.03(E) clearly states that:

[i]t is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.

Accordingly, Applicants respectfully submit that, in order to maintain the obviousness rejection, the Examiner either must produce references in support of the Examiner's contention or, if the Examiner is relying upon personal knowledge to support the finding of what is known in the art, the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanations to support the finding. See, e.g., M.P.E.P. § 2144.03 and 37 C.F.R. § 1.104(d)(2).

Regarding claim 35, it was brought to the Examiner's attention during the Interview that the TDH-39 standard, at the time the invention was made, was a well-known acoustic response standard for over-the-ear type headphones. Consequently, since the TDH-39 standard is not an earphone standard, it would not have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Hosaka by providing TDH-39 standard quality of frequency response in an "in the ear canal" earphone type device.

Regarding claim 36, claim 36 depends from independent claim 35. Because independent claim 35 is allowable over Hosaka, the Applicants respectfully submit that dependent claim 36 is also allowable over the cited reference. The Applicants assert that the rejections of claim 36 is now moot and requests that the rejection of dependent claim 36 under 35 U.S.C. § 103(a) over Hosaka be withdrawn.

III. Allowable Subject Matter

Claims 2, 37, and 42 were objected to as being dependant upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 2 depends from independent claim 1. Because independent claim 1 is allowable over Hosaka, the Applicants respectfully submit that dependent claim 2 is also allowable over the cited reference. The Applicants assert that the objection of claim 2 is now moot and request that the objection of dependent claim 2 be withdrawn.

Claim 37 depends from independent claim 35. Because independent claim 35 is allowable over Hosaka, the Applicants respectfully submit that dependent claim 37 is also allowable over the cited reference. The Applicants assert that the objection of claim 37 is now moot and requests that the objection of dependent claim 37 be withdrawn.

Claim 42 depends from independent claim 41. Because independent claim 41 is allowable over Hosaka, the Applicants respectfully submit that dependent claim 42 is also allowable over the cited reference. The Applicants assert that the objection of claim 42 is now moot and requests that the objection of dependent claim 42 be withdrawn.

IV. Comments on Statement of Reasons for Allowance

Applicants acknowledge with appreciation the Examiner's allowance of claims 24-34 and respectfully submit the following Comments on the Statement of Reasons for Allowance:

The Applicants respectfully submit that the Reasons for Allowance may potentially import interpretations into the claims in relation to the prior art that are unnecessarily limited and may place unwarranted interpretations upon the claims.

Such a characterization of the claims in view of the prior art may not properly take into account the Applicants' claimed invention as reflected in the claims, the specification and the prosecution history of the present application. Applicants believe that the claims, the specification, and the prosecution history in their entirety provide an adequate basis for the allowability of the claims.

Additionally, specific parts of the Examiner's reasons for allowance may pertain to limitations appearing in some of the claims, but not others of the claims. The Applicant respectfully submits that the Examiner has thoroughly examined the claims,

recognized the limitations appearing or not appearing in each of the claims, and properly found the claims to be allowable based on the record.

For example, with regard to independent claims 24 and 30, the Examiner recites that a prior art reference, Hosaka, teaches several elements of the claims. Although the Applicants respectfully agree with the Examiner's conclusion that the present claims are allowable over Hosaka, the Applicants do not necessarily adopt the Examiner's findings with regard to the teachings of Hosaka.


CONCLUSION

Based on at least the foregoing, Applicants believe that all pending claims are in condition for allowance. If the Examiner disagrees, Applicants respectfully request a phone interview, and request that the Examiner telephone the undersigned at 312-775-8000.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,


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